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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/003.698

10/31/2001

Frank J. Kronzer

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EXAMINER

DICUS, TAMIRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 01/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Applicant(s) FRANK J. KRONZER	
	Application No. 10/003,698	Art Unit 1774
	Examiner Tamra L. Dicus	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. Claims 1-32 of this application conflict with claims 1-30 of Application No. 10/003,697. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-32 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8 and 17-28 of copending Application No. 10/003,697. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 1-3, 5-18, 21-26, and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,232,267 to Oshima et al.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 4, 10, 21, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,232,267 to Oshima et al. in view of USPN 5,508,105 to Orenstein et al.

Response to Arguments

6. The Claim Objection is withdrawn due to Applicant's arguments.

7. Applicant's arguments filed 7-03-03 have been fully considered but they are not persuasive.

Applicant argues the Application number 10/003,697 is not drawn to identical subject matter because the Applicant believes the discontinuous printable polymer layer of 10/003,697 is not equivalent to the cross-linked polymer layers of presently examined Application 10/003,698.

The Examiner does not agree because the claims of '698 include a crosslinking agent as in instant claim 3 and the claims of '697 include a crosslinked printable polymer layer as in instant claims 8 and 13. What word one uses to define the same material does not serve to differentiate the material, therefore the Examiner upholds the double patenting rejection because the claims of '698 are the same as '697. To the Applicant's argument of Application 09/655,987, the Examiner erroneously referenced this application in paragraph 3 of the prior Office Action, as it should be 10/003,697 as previously set forth in paragraph 1 of the prior Office Action and as appeared in its corrected form above.

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8. Applicant continuously argues the structure of the heat transfer material when no limitations address any structure limitations anywhere in the claims. The claims merely address what materials and ingredients are and the prior art of record contains all the materials as presented previously. Applicant argues the location of the release coating to the adhesive layer and where the discontinuous image receptive layer is located to the carrier, all of which are not included in any limitation as aforementioned. Applicant also discusses thicknesses of Oshima versus Applicant's intentions, however, no claims include any limitation to thicknesses. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the structure of the material) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. Applicant discusses Oshima and alleges that Oshima fails to teach or suggest Applicant's claimed invention. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Oshima is provided to teach a thermal transfer sheet comprising a substrate of polypropylene, polyester films and processed paper (cellulosic nonwoven) (claims 12, 13, 17, 22, 26), a release coating layer, a white layer which may comprise a resin binder of fluoro carbon,

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melamine, polyurethane or silicone resins (cross-linkable binder) and an adhesive (opaque crosslinked polymer layer and/or discontinuous polymer layer having an opacifying material), a peeling film layer and a dye layer (discontinuous printable layer) adjacent to the adhesive layer. The peeling layer may also contain the white pigment (opacifying white pigment) (col. 5, lines 50-55). See col. 6, lines 1-35 and col. 8, lines 1-20.

10. Applicant alleges Orensteen simply teaches the use of aziridine. The Applicant merely claims aziridine. As previously set forth, Oshima does not teach adding aziridine. However, Orensteen teaches a thermal print receptive and retroreflective sheeting where he teaches adding crosslinker aziridine (multifunctional aziridine) increases weatherability and chemical resistance, improves the tendency of a top layer to lie flat and low curing temperatures in such a multi-function layer. For these reasons, it is an obvious modification to include in Oshima. See col. 9, lines 12-35.

11. To claims 19-20, 27 and 31-32, all claims are rejected under the double patenting rejection as previously set forth.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus
Examiner
Art Unit 1774

January 8, 2004



BRUCE H. HESS
PRIMARY EXAMINER